

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/749,601	12/31/2003	Timothy L. Hoopman	03001	8504	
44977	7590 01/23/2006		EXAMINER		
	N LAW OFFICES, LLC TREET NORTH		LAYNO, BENJAMIN		
OAKDALE,			ART UNIT	PAPER NUMBER	
•			3711		

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)				
Office Action Summary		10/749,601	HOOPMAN, TIMOTHY L.				
		Examiner	Art Unit				
		Benjamin H. Layno	3711				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply							
WHIC - External after - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR REPLY CHEVER IS LONGER, FROM THE MAILING DATE in the may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. Depriod for reply is specified above, the maximum statutory period were to reply within the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing ed patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tim vill apply and will expire SIX (6) MONTHS from a cause the application to become ABANDONE	N. nely filed the mailing date of this com D (35 U.S.C. § 133).				
Status							
1)⊠	Responsive to communication(s) filed on 14 No	ovember 2005.					
·	This action is FINAL . 2b) ☐ This action is non-final.						
3)□	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Dispositi	ion of Claims						
5)□ 6)⊠ 7)□	Claim(s) 1-17 is/are pending in the application. 4a) Of the above claim(s) is/are withdraw Claim(s) is/are allowed. Claim(s) 1-17 is/are rejected. Claim(s) is/are objected to. Claim(s) are subject to restriction and/or	vn from consideration.					
Applicati	ion Papers						
•	The specification is objected to by the Examine						
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.							
Priority u	ınder 35 U.S.C. § 119						
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 							
	t(s) te of References Cited (PTO-892) te of Draftsperson's Patent Drawing Review (PTO-948)	4) Interview Summary Paper No(s)/Mail Da	ate				
3) 🔲 Inform	mation Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) Notice of Informal P 6) Other:	atent Application (PTO-1	52)			

Application/Control Number: 10/749,601 Page 2

Art Unit: 3711

DETAILED ACTION

1. Applicant's arguments filed 11/14/05 have been fully considered but they are not persuasive. The rejections follow.

Claim Rejections - 35 USC § 102 or § 103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 3. Claims 1-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stauff.

The patent to Stauff discloses a pack of playing cards having many of the features recited in claims 1-17. Note, Stauff's first indicia (numerical values) in the primary corners and secondary corners are clearly **horizontally aligned** with the second indicia (suit) in a region bordering the top edge and the bottom edge. In Stauff's playing cards, the judicious placement of the second indicia (suit) in the first position being horizontally aligned with the right-reading first indicia in a region bordering the top edge, and the judicious placement of second indicia (suit) in the second position being

Art Unit: 3711

horizontally aligned with the upside-down reading first indicia in a region bordering the bottom edge, makes Stauff's playing cards **capable** of lessening the precision of vertical columnar alignment and columnar length over that obtainable with previously known pack of playing cards.

Page 3

Concerning claim 1, the recitation "a previously known pack of playing cards" is a relative term that is open to broad interpretation. Any pack of playing cards, e.g. (Uno playing cards, any of the playing cards in the references cited Jannersten, Hofman, Roberts, Nielsen, Raheb, Bommarito, Friedman, etc.) may be called "a previously known pack of playing cards".

In regard to claims, 2 and 9, the Examiner agrees with the Applicant's argument that Stauff's second indicia (suit) in the first position in the region bordering the top edge, and the second indicia (suit) in the second position in the region bordering the bottom edge, are both located at a point **midway** between primary and secondary corners. However, the Examiner takes the position that the term "horizontally proximate" is a relative term that is open to broad interpretation. Thus, Stauff's second indicia (suit) in the first position in the region bordering the top edge, and in the second position in the region bordering the bottom edge, are both located broadly horizontally proximate the right-reading first indicia in the region bordering the bottom edge, and the upside-down-reading first indicia in the region bordering the bottom edge, respectively.

Concerning claims 7 and 11, Stauff's playing cards in Figs. 1 – 9 clearly disclose second indicia (diamond suit), inside the regions bordered by the edges, as being

Art Unit: 3711

enlarged compared to the second indicia (diamond suit) located outside the region near the primary corners of the playing cards.

The only differences between the claimed invention, and Stauff's playing cards are:

- 1) In claims 2 and 9, the second indicia (suit) in the first position having a **right-reading orientation** in the region bordering the top edge, the second indicia (suit) in the second position having an **upside-down-reading orientation** in the region bordering the bottom edge. In Stauff's playing cards, the second indicia (suit) reading orientations are reversed, see Figs. 12 23.
- 2) In claims 5 and 16, the second indicia (suit) in the **seventh** position being proximate to and below the right-reading first indicia in the secondary corner in the region bordering the right edge, and the second indicia in the **eight** position being proximate to and above the upside-down-reading first indicia in the secondary corner in the region bordering the left edge. Stauff's playing cards do not have second indicia (suit) in the seventh and eight positions.
- 3) In claim 8, the picture on the Face Card has an upper half in a right reading orientation and similar lower half in an upside-down reading orientation such that the graphic looks similar whether seen right-side up or upside down. The Face Cards in Stauff's playing cards, Figs. 12 23 do not have this feature.

These differences only reside in the meaning and information conveyed by **printed matter**. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.

Furthermore or in the alternative, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stauff's playing cards by positioning the second indicia (suit) in the first position in a right-reading orientation in the top edge, positioning the second indicia (suit) in the second position in an upside-down-reading orientation in the bottom edge, providing second indicia (suit) in the seventh and eight positions, and replacing the pictures in Stauff's Face Cards with pictures having an upper half in a right reading orientation and similar lower half in an upside-down reading orientation such that the graphic looks similar whether seen right-side up or upside down. These modifications would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. In re Gulack, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of playing card does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is **no** novel or unobvious functional relationship between the claimed printed matter e.g. (positioning of the first indicia and second indicia, rightreading orientation, upside-down-reading orientation, position of second indicia on seventh and eight positions, pictures in Face Cards having an upper half in a right reading orientation and similar lower half in an upside-down reading orientation) and the substrate e.g. (playing card surface) which is required for patentability.

Application/Control Number: 10/749,601 Page 6

Art Unit: 3711

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571)272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number: 10/749,601 Page 7

Art Unit: 3711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Primary Examiner

Art Unit 3711

bhl